



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,315	10/24/2003	Takao Abe	AM100905P1	1495
25291	7590	09/15/2008		
WYETH PATENT LAW GROUP 5 GIRALDA FARMS MADISON, NJ 07940			EXAMINER BERCH, MARK L.	
			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			09/15/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

The amendment is entered and resolves the rejection under 35 USC 112.

The other rejection remains. Note that it is only against claims 1-20, the compound claims, not the use claims of the patent.

The traverse is unpersuasive on the other rejection. The examiner has cited both *Ex parte MacAdams*, 206 USPQ 445 and *Mosler Safe & Lock Co. v. Mosler, Bahmann & Co.*, 127 U.S. 354, 218 S.Ct. 1148 (1888). Applicants may wish to also note *In re Byck*, 9 USPQ 205, and *In re Freeman*, 76 USPQ 585, both of which also held no patentable distinction between the two, although in that case, patent had the method of making the object; the application had the object itself. But the principle is the same regardless of the sequence in time. Note *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 68 USPQ2d 1865 (CA FC 2003) which states at 1875: "a claim to a method of using a composition is not patentably distinct from an earlier claim to the identical composition in a patent disclosing the identical use". Although that decision involved method of use rather than method of making, the examiner sees no reason why one type of process should be treated differently from another. Similar is *In re Boylan*, 157 USPQ 370, where the patent had a composition of matter; the application had the method of use.

Applicants need to explain why they believe that the holdings of these cases are not applicable here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner
Art Unit 1624

9/16/2008